

REMARKS

Independent claims 1 and 13 have been amended to clarify the structure of Applicant's invention. Claims 27-32 have been newly canceled.

More specifically, each of claims 1 and 13 has been amended to substantially recite a generally circular cylindrical tube made of resilient material that forms an airtight outer circumferential boundary of a chamber. Support for the airtightness of the tube of resilient material can be found in the first full paragraph on page 11 of Applicant's specification, where it is stated that the chamber is filled with pressurized fluid.

That pressurized fluid supports the tube 44 in its generally circular cylindrical shape, providing a cushioning effect that allows slider clips or other objects to pass through the rollers. The pressurized fluid thereafter pushes the soft rubber material of tube 44 back to its original designed form (e.g., a circular cylinder) after the slider clip or other object passes through.

[See page 11, lines 14-19.] Obviously, the pressurized fluid inside the chamber could not push the resilient tube outward if the latter were perforated and not airtight.

In ¶ 3 of the office action, claims 1-11, 13-21, and 27-32 were rejected under 35 U.S.C. § 103(a) as being

unpatentable over Kane (US 6,212,944) in view of Satoh *et al.* (US 6,382,100). The Applicant traverses this ground of rejection for the following reasons.

To establish a *prima facie* case of obviousness, three basic criteria must be met, as set forth at MPEP 706.02(j). First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the combined prior art references must teach or suggest all the claim limitations.

Amended independent claims 1 and 13 recite a generally circular cylindrical tube made of resilient material, the tube forming an airtight outer boundary of a chamber. Neither Kane nor Satoh teaches this structure.

Satoh teaches a hollow roller 3 that is "perforated". [See Satoh, col. 6, line 65.] "[T]he roller 3 emits air from all over its perforated surface for holding the traveling web W away therefrom." [See Satoh, col. 7, lines 1 and 2.] Moreover, Satoh does not disclose that the roller 3 is made of resilient material.

Kane teaches a male die cylinder 58 having integrally machined die cavities 59 each defined by a cutting edge 61. [See Kane, col. 4, lines 28-37.] With regard to the preferred embodiment, Kane states:

The entire outer circumference of the male die cylinder 58 is covered with a resilient elastomer covering, forming elastomer pads 60 within the die cavities 59 having the shape of the cavities and thus the labels to be formed.

[See Kane, col. 4, lines 37-42.] Those elastomer pads do not form an "airtight" outer circumferential boundary of a chamber, as substantially recited in Applicant's claims 1 and 13. Not only are the elastomer pads separated by the cutting edges 61, the pads also have openings that are part of respective radial vacuum ports 62, which are in fluid communication with a phased vacuum chamber in the interior of the male die cylinder 58. [See Kane, col. 4, lines 48-53.]

Thus, Kane and Satoh both teach rollers/cylinders that have openings or perforations, which are thus incapable of providing an airtight boundary for an internal chamber of the roller/cylinder. Accordingly, the combined teachings of Kane and Satoh neither disclose nor suggest all of the limitations of either claim 1 or 13, meaning that the third criterion for a *prima facie* case of obviousness has not been satisfied. The

Applicant respectfully submits that the obviousness rejection based on the combination of Kane and Satoh should be withdrawn.

Furthermore, the office action is unclear concerning the basis for rejecting dependent claims 7 and 18, each of which recites that the tube comprises a multiplicity of annular transverse cuts extending from an inner peripheral surface of the tube toward, but not reaching, an outer peripheral surface of the tube. Although the Examiner asserts that Satoh discloses "transverse cut means", it is unclear which element depicted in Figure 2 corresponds to such means. In any event, Satoh does not disclose annular transverse cuts that start at the inner periphery and do not reach the outer periphery of the tube.

In view of the foregoing, the Applicant submits that this application is now in condition for allowance. Reconsideration of the application and allowance of claims 1-11 and 13-21 are hereby requested.

Respectfully submitted,


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Date

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